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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,834	10/07/2003	Douglas Hadfield	P385	5409
7590	01/07/2005		EXAMINER	
PAUL E. MILLIKEN 9061 WALL STREET, NW MASSILLON, OH 44646-1676			CLARKE, SARA SACHIE	
			ART UNIT	PAPER NUMBER
			3749	

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/680,834	HADFIELD, DOUGLAS	
	Examiner	Art Unit	
	Sara Clarke	3749	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on October 20 and 29, 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-5 and 11-17 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-5 and 11-17 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 20 October 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

<p>1)<input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.</p>	<p>4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.</p> <p>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6)<input type="checkbox"/> Other: _____.</p>
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DETAILED ACTION

Drawings

The drawings were received on October 4, 2004. These drawings are acceptable.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12, 14, and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

While the original disclosure provides support for six sides (see original claim 10 and Fig. 6), it does not provide support for more than six sides. Thus, the language "at least six sides" in new claim 17 is not supported by the original disclosure. Claims 12 and 14 depend from claim 17.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, 12, 14, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park (CH 665012) in view of Hendricks (US 3301249).

Park discloses the invention substantially as claimed with the exception of the fireback being formed as a single refractory cement casting.

Hendricks discloses a fireplace and teaches the use of making the fireback of a single refractory cement casting for the purpose of more quickly erecting the chimney structure. See column 1. See also column 4, lines 9-24.

Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to form the fireback of Park as a single refractory casting as taught by Hendricks for the purpose of erecting the chimney structure quickly.

Regarding claim 17, the applicant's recitation of the base having at least six sides presents no novel or unexpected result over the shape disclosed in Park. Furthermore, the applicant has not presented any evidence that such differences unexpectedly solve some problem or provide some new result in the art. Therefore, the use of a six-sided shape in lieu of the disclosed shape in Park would have been an obvious matter of design choice to one of ordinary skill in the art, and as such the claims do not patentably distinguish over the applied art at time of applicant's invention as one skilled in the art would have considered the change as an obvious matter of design choice.

Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park (CH 665012) and Hendricks (US 3301249), as applied to claim 1 above, and further in view of Zeller (CH 627832).

Park and Hendricks disclose the invention substantially as claimed with the exception of raised surface features in the form of corrugations or undulations, which

form peaks lying in planes substantially parallel to the base of the fireback.

Zeller discloses a fireplace and teaches the use of an insert including undulations (see Figs. 3 and 4) to improve heat absorption. See column 2, lines 40-44.

Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to provide the fireplace of Park and Hendricks with undulations as taught by Zeller for the purpose of improving heat absorption.

Claims 11, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park (CH 665012) and Hendricks (US 3301249), as applied to claim 1 above, and further in view of Buffington (US 2003/0019490).

Park and Hendricks disclose the invention substantially as claimed with the exception of a semi-circular cross-section and is frustoconical in shape.

Buffington discloses a fireplace and teaches the use of a semi-circular interior (see the abstract and Fig. 3) for the purpose of providing a kiva-style fireplace.

Thus, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to provide the fireplace of Park and Hendricks with a semi-circular shape (and consequently a frustoconical 3D shape) as taught by Buffington for the purpose of changing the style of the fireplace to be more kiva-like.

Response to Arguments

Applicant argues that Park, Andrews, and Zeller are not relevant to the present invention since they relate to non refractory convection fires. The examiner disagrees.

In the original disclosure, for which the inventor signed a declaration, the field of invention (page 1, lines 5 and 6 of the specification) is defined as relating to "open fireplaces and firebacks of a type for use with open fireplaces." Clearly, Park, Andrews,

and Zeller are all analogous to this field of invention.

Applicant argues that while Hendricks and Buffington both disclose refractory fires, they do not disclose the claimed frustoconical or pyramidal surfaces. As noted above, Park is analogous prior art. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, at least claim 1 is rejected under 35 U.S.C. 103 over a combination of references including Park. The Park reference teaches the shape recited in claim 1.

Applicant further argues that Buffington does not disclose "walls sloping steadily inwards from the firebed to the throat." In response it is noted that the language used in applicant's arguments do not match the language of the claims. Buffington does disclose the claimed shape of "a generally frustoconical shape . . . sloping steadily inward towards the throat . . . the section of the fireback having a larger area at a height substantially at the level of the firebed and a smaller area adjacent the throat." (claim 1)

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wade (US 6029654) discloses a refractory convection fireplace.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this or earlier communications from the examiner should be directed to Sara Clarke whose phone number is 571-272-4873. The examiner normally can be reached Mon-Fri, 8:30-1:00.

If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Ira Lazarus, can be reached at 571-272-4877. The fax number for the organization where this application is assigned is 703-872-9306.

Status information for an application is available from the Patent Application Information Retrieval (PAIR) system. Status information for published applications is available from Private or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about PAIR, see <http://pair-direct.uspto.gov>. For questions on access to Private PAIR, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sara Clarke
Primary Examiner
Art Unit 3749

January 5, 2005